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Fujitsu Patent Center
Fujitsu Management Services of America, Inc.
2318 Mill Road, Suite 1010
Alexandria, VA 22314

| EXAMINER |
|---|
| STRODER, CARRIE A |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

fpc-mailroom@us.fujitsu.com
eoamule@system.foundationip.com
tiep.nguyen@us.fujitsu.com

PTOL-90A (Rev. 04/07)

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *19 January 2011*.
2a)☐ This action is **FINAL**.           2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *14-23* is/are pending in the application.
      4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *14-23* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
      Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
      Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
      a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
      * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
      Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

**DETAILED ACTION**

1.    This is in response to the applicant's communication filed

on 19 January 2011, requesting continued examination (RCE)

wherein:

      Claims 14-23 are currently pending;

      claims 14-21 are currently amended;

      claims 22-23 are new; and

      claims 1-13 are cancelled.

*Information Disclosure Statement*

1.    The information disclosure statement (IDS) submitted on 21

June 2010 is in compliance with the provisions of 37 CFR 1.97.

Accordingly, the information disclosure statement was considered

by the examiner on 19 August 2010.

*Claim Rejections - 35 USC § 112*

1.    The following is a quotation of the second paragraph of 35

U.S.C. 112:

> The specification shall conclude with one or more claims particularly
> pointing out and distinctly claiming the subject matter which the applicant
> regards as his invention.

2.   **Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14-19 claim to be an apparatus; however, Examiner is not sure what structure is described.  For example, claim 14 refers to various "units"; however, what the structure of these units are, is unclear.  Examples of structure include a processor, a display device, and a keyboard.  Only structural aspects of an apparatus claim receive patentable weight; however, to expedite prosecution, Examiner has given weight to the claimed functionality for the art rejections, below.  Claim 14 also refers to a "database" which does not provide definite structure.  A database can be simply a collection of data, which is not structure.  Or, it can be an electronic database, which provides structure.  Claim 14 also refers to "memory."  It is not clear in the claim what sort of structure, if any, is being provided.  "Memory" may refer to human memory, a transitory signal, computer memory, or computer readable memory, such as a CD or DVD.  Examiner assumes, for the purposes of examination, that "memory" refers to non-transitory computer memory, and that "database" refers to an electronic database.

### *Claim Rejections - 35 USC § 101*

3.    35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful improvement
> thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

**Claim 20 is rejected under 35 U.S.C. § 101** because the claimed

invention is directed to non-statutory subject matter.  Based

upon consideration of all of the relevant factors with respect

to the claims as a whole, claim 20 is held to claim an abstract

idea, and are therefore rejected as ineligible subject matter

under 35 U.S.C. 101.  The rationale for this finding is

explained below:


Based on Supreme Court precedent and recent Federal Circuit

decisions, the Office's guidance to an examiner is that one clue

to patent eligibility under 35 USC 101 is whether or not the

process is (1) be tied to a particular machine or apparatus or

(2) transforms underlying subject matter (such as an article or

materials) to a different state or thing.  Diamond v. Diehr, 450

U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9

(1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane

v. Deener, 94 U.S. 780, 787-88 (1876).

The claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because there is no tie to any kind of machine for any of the claimed steps. Although the preamble of claim 20 refers to a processor, this limitation is not recited in the body of the claim and therefore, receives little patentable weight.  Claim

20 does mention databases in the body of the claim; however, a database does not necessarily provide a tie to a particular machine. A database may be simply a collection of papers, which does not involve a particular machine.

Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

Additionally, other factors and considerations in addition to the machine/transformation test also point to a finding that the claims are directed to a mere abstract idea. The claims also seem to be a mere statement of a general concept of product registration. The claims if allowed would appear to effectively grant a monopoly on the concept of product registration as claimed. The claims seem to be directed to a general business concept of product registration, which seems to be just a general business concept. When viewing these factors and the claims as whole, it is concluded that the claims are directed to

a mere abstract idea and are not patent eligible under 35 USC

101.

## *Claim Rejections - 35 USC § 102*

1.    The following is a quotation of the appropriate paragraphs

of 35 U.S.C. 102 that form the basis for the rejections under

this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in
> this or a foreign country or in public use or on sale in this country, more
> than one year prior to the date of application for patent in the United
> States.

2.    **Claims 14, 16-17, and 20-21 are rejected under 35**

**U.S.C. 102(b) as being anticipated by Highbloom (US 5623403).**

     **Referring to claim 14:**

     Highbloom discloses

     a product information acquisition unit that acquires

product information including a product ID (identification)

identifying a product to be registered (col. 7, lines 35-55;

"…comparing the VIN against a prestored range of valid VIN

numbers provided by the manufacturers" where it is inherent that

the VIN is acquired and where a VIN is interpreted as a product

ID);

a first database that registers product information
including a product ID of a shipped product (col. 7, lines 35-
55; "…comparing the VIN against a prestored range of valid VIN
numbers provided by the manufacturers" where the "prestored
range of valid VIN numbers" is interpreted as a database);

a second database that registers an acquired product
information acquired by the product information acquisition unit
(col. 7, lines 35-55; "If the error cannot be corrected, the
record may still be entered into the memory 26…" and where the
memory 26 is a second database);

a proper registration propriety decision unit that refers
to the product information registered in the first database by
using the acquired product information, and decides whether or
not the acquired product information is to be properly
registered to the second database based on whether or not a
product ID of the acquired product information is registered in
the first database (col. 7, lines 35-55; "An optional third step
may be performed which includes comparing the VIN against a
prestored range of valid VIN numbers provided by the
manufacturers. If the VIN passes all of the provided steps, the
record 38 or 40 is entered into the memory 26 of the monitoring
computer 12 for subsequent data comparisons by the data
comparator 28.");

a memory that stores temporary registration condition

information providing a condition permitting temporary

registration of product information (col. 7, lines 35-55 and

col. 8, lines 6-24; "If the error cannot be corrected, the

record may still be entered into the memory 26 but is flagged

for error reporting and is not processed by the data comparator

28." and "The information is first routed to a main volatile

memory which temporarily stores the information..."); and

a temporary registration unit that temporarily registers

the acquired product information to the second database when the

acquired product information is decided as improper to be

registered to the second database by the proper registration

propriety decision unit and when the acquired product

information meets the temporary registration condition

information (col. 7, lines 35-55 and col. 8, lines 6-24; "If the

error cannot be corrected, the record may still be entered into

the memory 26 but is flagged for error reporting and is not

processed by the data comparator 28." and "The information is

first routed to a main volatile memory which temporarily stores

the information...").

**Referring to claim 16:**

Highbloom discloses

wherein the temporary registration condition information
includes at least a product ID identifying a product (col. 7,
lines 35-55; "…comparing the VIN against a prestored range of
valid VIN numbers provided by the manufacturers" and where "VIN"
is interpreted as a product ID), and

the temporary registration unit refers to the memory by
using the product ID included in the acquired product
information decided as improper to be registered to the second
database so as to decide whether or not the acquired product
information decided as improper to be registered to the second
database is to be temporarily registered to the second database,
and temporarily registers the acquired product information
decided as improper to be registered to the second database, to
the second database when the product ID included in the improper
product information is decided to be properly registered to the
second database (col. 7, lines 35-55; "An optional third step
may be performed which includes comparing the VIN against a
prestored range of valid VIN numbers provided by the
manufacturers. If the VIN passes all of the provided steps, the
record 38 or 40 is entered into the memory 26 of the monitoring
computer 12 for subsequent data comparisons by the data

comparator 28." and "If the error cannot be corrected, the

record may still be entered into the memory 26 but is flagged

for error reporting and is not processed by the data comparator

28.").

Examiner notes that this claim contains only limitations

which do not further limit the structure of the claimed

invention.  Applicant appears to be attempting to define the

apparatus by what it <u>does</u> rather than what it <u>is</u>.  Examiner

reminds applicant that little patentable weight is given to non-

structural limitations in an apparatus claim.


**Referring to claim 17:**

Highbloom discloses

the memory stores temporary registration condition

corresponding to a product ID (col. 7, lines 35-55; "An optional

third step may be performed which includes comparing the VIN

against a prestored range of valid VIN numbers provided by the

manufacturers. If the VIN passes all of the provided steps, the

record 38 or 40 is entered into the memory 26 of the monitoring

computer 12 for subsequent data comparisons by the data

comparator 28."), and

the temporary registration unit refers to the temporary

registration condition stored in the memory by using a product

ID included in a product information decided as improper to be

registered to the second database, and decides that the improper

product information to be registered to the second database when

the product ID included in the improper product information is

decided to be properly registered to the second database (col.

7, lines 35-55; "If the VIN fails any of theses tests, the error

is analyzed to determine whether it can be corrected." and "If

the error cannot be corrected, the record may still be entered

into the memory but is flagged for error reporting and is not

processed by the data comparator.").

Examiner notes that this claim contains only limitations

which do not further limit the structure of the claimed

invention.  Applicant appears to be attempting to define the

apparatus by what it <u>does</u> rather than what it <u>is</u>.  Examiner

reminds applicant that little patentable weight is given to non-

structural limitations in an apparatus claim.


**Referring to claims 20 and 21:**

Highbloom discloses

acquiring product information including a product ID

(identification) identifying a product to be registered (col. 7,

lines 35-55; "…comparing the VIN against a prestored range of

valid VIN numbers provided by the manufacturers" where it is

inherent that the VIN is acquired and where a VIN is interpreted
as a product ID);

referring to a first database which registers product
information of a shipped product, by using the acquired product
information so as to decide whether or not the acquired product
information is to be properly registered to a second database
which registers an acquired product information, based on
whether or not the acquired product information is registered in
the first database (col. 7, lines 35-55; "An optional third step
may be performed which includes comparing the VIN against a
prestored range of valid VIN numbers provided by the
manufacturers. If the VIN passes all of the provided steps, the
record 38 or 40 is entered into the memory 26 of the monitoring
computer 12 for subsequent data comparisons by the data
comparator 28."); and

registering the acquired product information temporarily to
the second database when the acquired product information is
decided as improper to be registered to the second database by
the referring and when the acquired product information meets
temporary registration condition information providing a
condition permitting temporary registration of product
information (col. 7, lines 35-55 and col. 8, lines 6-24; "If the
error cannot be corrected, the record may still be entered into

the memory 26 but is flagged for error reporting and is not
processed by the data comparator 28." and "The information is
first routed to a main volatile memory which temporarily stores
the information...").

**Referring to claim 22:**

Highbloom discloses wherein the temporary registration
condition information indicates a condition for selecting a
product which has a possibility of an invalid product ID (col.
7, lines 35-55; "An optional third step may be performed which
includes comparing the VIN against a prestored range of valid
VIN numbers provided by the manufacturers. If the VIN passes all
of the provided steps, the record 38 or 40 is entered into the
memory 26 of the monitoring computer 12 for subsequent data
comparisons by the data comparator 28.").

*Claim Rejections - 35 USC § 103*

4.    The following is a quotation of 35 U.S.C. 103(a) which
forms the basis for all obviousness rejections set forth in this
Office action:

> (a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the
art to which said subject matter pertains.  Patentability shall not be
negatived by the manner in which the invention was made.

5.   The factual inquiries set forth in *Graham* v. *John Deere*

*Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and
     the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent
     art.
4.   Considering objective evidence present in the
     application indicating obviousness or nonobviousness.

6.   **Claims 15 and 18-19 are rejected under 35 U.S.C. 103(a) as**

**being unpatentable over Highbloom (US 5623403), in view of**

**Carey, Joan and Patrick, "Microsoft Access 2000 At a Glance"**

**1999 (hereinafter referred to as "Carey").**


**Referring to claim 15:**

Highbloom discloses using a database for monitoring

registration information, as set forth in claim 14.  Highbloom

does not disclose a decision unit that decides whether a product

ID included in a product information that has been temporarily

registered in the second database is a product ID that is

registered again in the first database during a designated

temporary registration period or a registration unit that
changes the temporarily registered product information in the
second database to a formally registered product information
when the decision unit decides the product ID included in the
product information is registered again in the first database
during the designated temporary registration period.

However, Carey teaches how to use Microsoft Access 2000, a
commonly used database.  Carey teaches a decision unit that
decides whether a product ID included in a product information
that has been temporarily registered in the second database is a
product ID that is registered again in the first database during
a designated temporary registration period (pages 56 and 103-
108; "You can specify several query fields…Access retrieves
records for which all of the criteria are satisfied…" and "You
can create a query that retrieves all the records from the
Orders table that have duplicate values for the CustomerID
field" where date and product ID may be fields in a database
table and where the name of the fields does not patentably
distinguish over the prior art), and

a registration unit that changes the temporarily registered
product information in the second database to a formally
registered product information when the decision unit decides
the product ID included in the product information is registered

again in the first database during the designated temporary

registration period (pages 56, 103-108, and 110-111; "You can

use a query to add records to a table by creating an append

query").

It would have been obvious for a person of ordinary skill in

the art (PHOSITA) at the time of invention to modify the system

for using a database to monitor registration information

disclosed in Highbloom to incorporate a decision unit that

decides whether a product ID included in a product information

that has been temporarily registered in the second database is a

product ID that is registered again in the first database during

a designated temporary registration period and a registration

unit that changes the temporarily registered product information

in the second database to a formally registered product

information when the decision unit decides the product ID

included in the product information is registered again in the

first database during the designated temporary registration

period as taught by Carey because this would provide a manner in

which to track product registrations, thus aiding the client by

reducing fraud and errors which may increase the cost to the

client.

Examiner notes that this claim contains only limitations

which do not further limit the structure of the claimed

invention.  Applicant appears to be attempting to define the apparatus by what it <u>does</u> rather than what it <u>is</u>.  Examiner reminds applicant that little patentable weight is given to non-structural limitations in an apparatus claim.


**Referring to claim 18:**

Highbloom discloses

a registration unit that decides whether or not the product ID included in the acquired product information registered in the second database is registered in the first database by referring to the first database (col. 7, lines 35-55; "An optional third step may be performed which includes comparing the VIN against a prestored range of valid VIN numbers provided by the manufacturers. If the VIN passes all of the provided steps, the record 38 or 40 is entered into the memory 26 of the monitoring computer 12 for subsequent data comparisons by the data comparator 28.", and

Carey teaches

that changes the temporarily registered product information in the second database to a formally registered product information when the product ID included in the product information is registered in the first database (pages 56, 103-

108, and 110-111; "You can use a query to add records to a table

by creating an append query").


**Referring to claim 19:**

Carey teaches wherein the registration unit cancels

temporary registration of the acquired product information in

the second database when the product ID included in the acquired

product information is not registered in the first database in a

designated temporary registration period (pages 104, 109, and

112; "…you might want to find which records in one table have no

match in the other table" and "If you want to remove records

from a table based on a criterion or criteria, you can do so

with a delete query.").


**Referring to claim 23:**

Carey teaches wherein the temporary registration condition

information indicates a condition for selecting a product

identified by a product ID including a lot number which

indicates a production line where there was a mistake in ID

assignment in a past (pages 56 and 103-108; "You can specify

several query fields…Access retrieves records for which all of

the criteria are satisfied…" and "You can create a query that

retrieves all the records from the Orders table that have

duplicate values for the CustomerID field" where lot numbers

which indicate a production line where there was a mistake in ID

assignments in the past may be a field in a database table and

where the name of the fields does not patentably distinguish

over the prior art).

## *Response to Arguments*

Applicant's arguments filed 19 January 2011 have been fully

considered but they are not persuasive.

Applicant notes in his remarks that the IDS submitted on June

21, 2010 was not considered.  However, the IDS was considered by

Examiner and shows as such in the computer records of the USPTO.

Examiner can only assume that applicant did not receive a signed

copy due to a printing or computer error and apologizes for any

confusion.

As to the claim rejections under 35 USC §112, applicant argues

that the amended claims now possess structure.  However, as is

stated above, a "unit" does not describe any structure, nor does

database and memory necessarily imply structure.

As to the rejections under 35 USC §101, Examiner has clarified

why claim 20 remains rejected above.


Regarding the rejections under 35 USC §102 and §103, applicant

argues that the prior art does not provide a <u>condition</u> which

permits <u>temporary</u> registration.  Examiner respectfully

disagrees.  Highbloom, in col. 7, lines 35-55 provides a

condition for temporary registration, that of the VIN failing

the tests described.  Highbloom also provides that the

registration is temporary in col. 8, lines 6-24, which states

that the memory which stores the information which is marked as

an error, does so temporarily.  Further, Examiner again points

out that these items do not limit the apparatus of claims 14-19,

and therefore, receive little patentable weight.


### Conclusion


Any inquiry concerning this communication or earlier

communications from the examiner should be directed to CARRIE A.

STRODER whose telephone number is (571)270-7119.  The examiner

can normally be reached on Monday - Thursday 8:00 a.m. - 5:00

p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/CARRIE A. STRODER/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689